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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,145	12/30/2005	Dung Dao Viet	ETI0036US	4566
23413 7590 10/07/2009 CANTOR COLBURN, LLP 20 Church Street 22nd Floor Hartford, CT 06103				
EXAMINER HUANG, CHENG YUAN				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
10/07/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptopatentmail@cantorcolburn.com

Office Action Summary

Application No.

10/563,145

Applicant(s)

VIET ET AL.

Examiner

CHENG HUANG

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-US)
Paper No(s)/Mail Date 20051230
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group II, claims 21-25 in the reply filed on 22 July 2009 is acknowledged.
2. Claims 1-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 22 July 2009.

Drawings

3. The drawings are objected to because the character references are not clear. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. (U.S. Patent No. 4,863,782) in view of Eby et al. (U.S. Patent No. 6,753,066) and Schmidle et al. (U.S. Patent No. 4,491,616).

7. Regarding claim 21, Wang et al. teaches a surface covering (See Title) which comprises a substrate (felt layer 60, col. 9, lines 27-28), a plastic layer overlaying the substrate (foamed layer 62, col. 9, line 29-30), an ink printed in a pattern or design on said plastic layer (printing design 64, col. 9, line 41, Fig. 10), and a non cured coating overlaying the plastic layer and the ink (second layer 66, col. 9, lines 64-65, Fig. 10). A layer is considered to be a coating.

8. Wang et al. fails to teach a cured coating overlaying the non-cured coating.
9. However, Eby et al. teaches a surface covering (See Title) wherein a cured coating overlaying an ink is mechanically embossed (col. 3, lines 46-62 and 35-39).
10. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a cured coating overlaying the non-cured coating of Wang et al. to further protect underlying layers.
11. Wang et al. fails to teach an ink containing a photoinitiator or that the plastic layer is gelled.
12. However, Schmidle et al. teaches a surface covering (See Title) comprising an ink containing a photoinitiator (col. 9, lines 3-8, col. 12, lines 1-4, col. 3, lines 54-62).
13. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a photoinitiator in the ink of Wang et al. to create surface areas with an embossed flat, dead, or dull mat finish or texture (Schmidle et al, col. 3, lines 54-59).
14. Schmidle et al. further teaches wherein a plastic layer is gelled (col. 6, line 39, col. 7, line 67).
15. It would have been obvious to one of ordinary skill in the art at the time of the invention to gel the plastic layer of Wang et al. for easier handling and processing (col. 7, line 67-col. 8, line 34).
16. The limitations “obtained by the method according to claim 1” and “mechanically embossed” are process limitations. It is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product

in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

17. Therefore, absent evidence of criticality regarding the presently claimed process and given that Wang et al. as modified by Eby et al. and Schmidle et al. meets the requirements of the claimed surface covering, the prior art clearly meets the requirements of present claims. Furthermore, the claimed limitations of embossing are taught by the prior art, as disclosed above.

18. Regarding claim 22, Wang et al. teaches a surface covering (See Title) which comprises a substrate (felt layer 60, col. 9, lines 27-28), a foamed and chemically embossed plastic layer overlaying the substrate (foamed layer 62, col. 9, line 29-30, col. 10, lines 31-39), an ink printed in a design on said foamed plastic layer (printing design 64, col. 9, line 41, Fig. 10), and a non cured coating overlaying the foamed plastic layer and the ink (second layer 66, col. 9, lines 64-65, Fig. 10).

19. Wang et al. fails to teach a cured coating or cured layer overlaying the non-cured coating.

20. However, Eby et al. teaches a surface covering (See Title) wherein the portion of the cured coating or layer overlaying an ink is chemically and/or mechanically embossed (col. 3, lines 46-62 and 35-39).

21. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a cured coating overlaying the non-cured coating of Wang et al. to further protect underlying layers.

22. Wang et al. fails to teach an ink containing a photoinitiator.

23. However, Schmidle et al. teaches a surface covering (See Title) comprising an ink containing a photoinitiator (col. 9, lines 3-8, col. 12, lines 1-4, col. 3, lines 54-62).

24. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a photoinitiator in the ink of Wang et al. to create surface areas with an embossed flat, dead, or dull mat finish or texture (Schmidle et al, col. 3, lines 54-59).

25. Limitations regarding "chemically embossed" and "mechanically embossed" are process limitations. It is noted that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process", *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, "although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product", *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

26. Therefore, absent evidence of criticality regarding the presently claimed process and given that Wang et al. as modified by Eby et al. and Schmidle et al. and meets the requirements

of the claimed surface covering, the prior art clearly meets the requirements of present claims.

Furthermore, the recited limitations are taught by the prior art, as disclosed above.

27. Regarding claim 23, Wang et al. teaches a surface covering (See Title) wherein the ink also contains an inhibitor (col. 9, lines 51-61).

28. Regarding claim 24, Wang et al. as modified by Eby et al. and Schmidle et al. teaches a surface covering (Wang et al., See Title) wherein the portion of the cured coating or cured layer, which is not disposed over the ink, is embossed with a texture different from the embossed portion of the cured coating disposed over the ink, given that with the inclusion of the photoinitiator of Schmidle et al in the ink of Wang et al. the portion of the cured coating that is not disposed over the ink will have a texture different from the portion of the cured coating disposed over the ink (Schmidle et al., See Figure 4A).

29. The limitation “mechanically embossed” is a process limitation. It is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

30. Therefore, absent evidence of criticality regarding the presently claimed process and given that Wang et al. as modified by Eby et al. and Schmidle et al. and meets the requirements of the claimed surface covering, the prior art clearly meets the requirements of present claims. Furthermore, the claimed limitation is taught by the prior art, as disclosed above.

31. Furthermore, the claimed limitation is regarded as a matter of design choice given that having certain portions to be texturally different from other portions is an aesthetic design change. See MPEP 2144.04 (I).

32. Regarding claim 25, Wang et al. fails to teach wherein the cured coating or cured layer further comprising comprises a polyurethane coating.

33. However, Eby et al. teaches a surface covering (See Title) wherein a cured layer (wear layer, col. 5, lines 21-24) further comprising comprises a polyurethane coating (top coat, col. 8, lines 9-13).

34. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a polyurethane coating in the cured coating or layer of Wang et al. to provide surface gloss or shine (Eby et al., col. 10, lines 19-22).

Conclusion

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHENG YUAN HUANG whose telephone number is (571) 270-7387. The examiner can normally be reached on Monday-Thursday from 8 AM to 4 PM.

36. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho, can be reached at 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

37. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. H./

Cheng Yuan Huang

Examiner, Art Unit 1794

September 28, 2009

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1794